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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/930,779

08/15/2001

Jeremy Burr

INTL-0658-US (P11212)

2581

21906

7590

05/17/2006

TROP PRUNER & HU, PC
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EXAMINER

TRAN, TUAN A

ART UNIT

PAPER NUMBER

2618

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/930,779
Filing Date: August 15, 2001
Appellant(s): BURR, JEREMY

Timothy N. Trop
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03/01/2006 appealing from the Office action mailed 11/04/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,590,928

HAARTSEN

7-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

1. Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Haartsen (6,590,928).

Regarding claim 1, Haartsen discloses a system and method for establishing communications between devices within a mobile network, comprising: obtaining on a first wireless device a contact list of second wireless devices with which the first wireless device has communicated in the past (through the inquiry procedure), including a first active contact in-range from the device and a second active contact being out-of-range from the device (See figs. 6a, 6b and col. 13 line 54 to col. 14 line 43); automatically establishing a communication route from the first wireless device to the

first contact and establishing a communication route from the first wireless device to the second contact through the first contact (See col. 14 line 43 to col. 15 line 37, col. 18 line 6 to col. 19 line 5).

Claims 11 and 21 are rejected for the same reasons as set forth in claim 1, as apparatus.

Regarding claim 2, Haartsen discloses as cited in claim 1. Haartsen further discloses the step of obtaining the contact list includes acquiring information from a list of addresses on the first wireless device (See col. 13 line 54 to col. 14 line 43).

Claims 12 and 22 are rejected for the same reasons as set forth in claim 2, as apparatus.

Regarding claims 3-8, Haartsen discloses as cited in claim 1. Haartsen further discloses the steps of: storing information related to the first and second active contacts sufficient to establish communication routes from the first wireless device to the first and second active contacts (See col. 15 lines 24-37); exchanging lists of contacts with in-range devices; comparing the lists of contacts; identifying common contacts in the lists; and exchanging lists of common contacts between two devices with other in-range devices (See fig. 8 and col. 14 lines 37-42, col. 16 lines 19-65).

Claims 13-18 and 23-28 are rejected for the same reasons as set forth in claims 3-8, as apparatus.

Regarding claim 9, Haartsen discloses as cited in claim 1. Haartsen further discloses the step of periodically updating information about in-range devices (See col. 13 line 54 to col. 14 line 5).

Claims 19 and 29 are rejected for the same reasons as set forth in claim 9, as apparatus.

Regarding claim 10, Haartsen discloses as cited in claim 1. Haartsen further discloses the step of storing alternative communication route to the second contact (See fig. 11 and col. 15 lines 24-37, col. 18 lines 15-65).

Claims 20 and 30 are rejected for the same reasons as set forth in claims 10, as apparatus.

(10) Response to Argument

The Appellant argued that there is no teaching of a list on a first wireless device with both in-range and out-of-range devices with which the first device has communicated in the past is set forth in the cited reference (See Appeal Brief, Argument section, pages 10-11). The Examiner respectfully disagrees with the Appellant's argument because of the following reasons:

The Appellant fails to indicate that the obtained contact list comprises **only** devices with which the first wireless device has communicated in the past. The claims are not so narrow as to prevent the list from including other devices. Therefore, the cited reference, Haartsen, perfectly reads on the claimed subject matters **wherein the first wireless device obtains the contact list of the second devices (the first contacts) in-range by communicating directly with them during the inquiry process ("devices with which the first device has communicated in the past") (See Haartsen, col. 13 line 66 to col. 14 lines 5, col.15 lines 8-37) as well as other devices (the second contacts) out-of-range with which the first device has not**

directly communicated (See Haartsen, col. 15 lines 8-37), and automatically establishes a communication route between the first device and the second devices (the first contacts) as well as a communication route to the other devices (the second contacts) through the second devices (the first contacts) (See Haartsen, col. 15 lines 27-45, col. 16 lines 19-65).

In accordance to *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997), claims are given their broadest reasonable interpretation in light of supporting disclosure wherein the obtained contact list by the first wireless device, as disclosed by the Specification, does not appear to include only devices with which the first device has communicated in the past but other devices as well (See Specification, fig. 1, page 4 lines 9-11, page 5 lines 6-9). Therefore, as mentioned above not only the claim, but the supporting disclosure (the Specification) as well, fails to indicate the obtained contact list comprises only devices with which the first wireless communication device has communicated in the past.

(11) Related Proceeding(s) Appendix

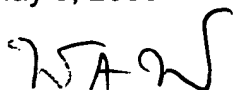
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Tuan Tran

May 3, 2006



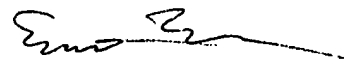
Art Unit: 2682

Conferees:

Matthew D. Anderson – Supervisor Patent Examiner

A handwritten signature in black ink, appearing to read 'M. D. Anderson', with a long horizontal flourish extending to the right.

Edward Urban – Supervisor Patent Examiner

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